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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,280	08/13/2002	Richard Courthope Giles	2373/103	2368
2101	7590	12/01/2004	EXAMINER	
BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			SELF, SHELLEY M	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/936,280	GILES ET AL.
	Examiner	Art Unit
	Shelley Self	3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 September 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 16-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 26-29 is/are allowed.
- 6) Claim(s) 16-19, 21, 30-33, 45 and 51-54 is/are rejected.
- 7) Claim(s) 20, 22-25, 34-44, 46-50 and 55-57 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 10 September 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Response to Amendment***

The amendment filed on September 16, 2004 has been considered and an action on the merits follows.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 16-25, 30-50 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 16, the claim fails to positively recite the critical interrelationship between the transport means and the rotary saw. For example are the saw and transport means operatively connected to each other, if not to what? The term, "adjacent" merely means next to and does not positively recite connecting or contiguous. Clarification is required.

With regard to claims 21, 30 and 45 it is unclear how the anvil is "controllably moveable", i.e. the claims fails to positively recite what or how is the anvil controlled.

Additionally, regarding claims 21, 30 and 45, there is no antecedent basis for the term, "*the angle of incidence*". Correction is required.

Claim 45 would be allowable if re-written to over come the 35 U.S.C. 112 rejections.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson (DE3141940) in view of Holmes (6,026,869). Carlsson discloses a tree harvesting apparatus adapted for mounting on a vehicle to effect continuous tree harvesting, said apparatus comprising a sawing/cutting means for cutting a tree near ground level (15,17), a transport means (15) adjacent said saw for gripping a tree cut by the saw/cutting means and transporting the tree to and dropping (fig. 1) said cut tree in a chipping means (9) located at an end of the transport means (Examiner notes the tree is vertically guided from above, i.e. dropped into a chipper 9) distant the saw/cutting means for chipping the tree; wherein in use when said tree harvesting apparatus is mounted on the vehicle said vehicle driven along a row of trees can continuously cut, chip said trees. Carlsson does not disclose the cutting/sawing means to be a rotary saw. Holmes teaches in a similar art, the use of a rotary saw having a leading edge below a trailing edge for cutting/felling a tree prior to transport of the cut/felled tree to a chipping means. Because the references are from a closely related art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Carlsson's cutting/sawing means with a rotary saw or any cutting sawing means so as to efficiently cut the tree prior to the chipping operation, as taught by Holmes.

Claims 20 and 30-33 and 51-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlsson (DE3141940) in view of Holmes (6,026,869) as applied to claim 16 above, and further in view of Lyman et al. (5,819,825). Neither Carlsson nor Holmes disclose a rotary drum with a moveable anvil. Lyman teaches in a closely related art, the use of a rotary drum in combination with a moveable anvil (Abstract) for varying the chip size in a rotary chipping machine. Because the references are from a closely related art, it would have been obvious at the time of the invention to one having ordinary skill in the art to replace, Carlsson's chipping means (9) with a rotary chipping means having a moveable anvil so as adjust vary chip size as taught by Lyman.

***Allowable Subject Matter***

Claims 26-29 are allowed.

Claims 20, 22-25, 34-44, 46-50 and 55-57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

Applicant's arguments, filed September 16, 2004, with respect to the rejection(s) have been carefully considered and are persuasive. Accordingly, the rejections have been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Carlsson, as noted above.

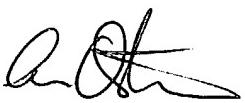
***Conclusion***

Due newly applied reference(s) above, this Office Action is made non-Final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Allen Ostrager can be reached at (571) 272-4521. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf  
November 22, 2004



ALLEN OSTRAGER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700